

REMARKS

In the Office Action dated March 7, 2005, the Examiner: (i) rejected claims 1, 5, 6, 8, 14, 18, 19, 20, 24, 25, 26, 27, 28, and 29 under 35 U.S.C. § 102(a) as anticipated by www.webcrawler.com ("Webcrawler"); and rejected claims 2, 3, 4, 7, 10, 11, 12, 13, 15, 16, 17, 21, 22, and 23 under 35 U.S.C. § 103(a) was unpatentable over Webcrawler in view of U.S. Patent No. 5,715,415 to Dazey et al ("Dazey").

In response, Applicant has amended Claims 1, 8, 11, 14, 19, 22, and 24; canceled claims 2, 9 and 21 (to add their limitations to Independent Claims 1, 8, and 19, respectively); and added new Claims 30-31. Claims 1, 3-8, 11-20, 22-31 are pending after this Amendment and Response.

Applicant thanks the Examiner for the Interview in which he further explained the rejections under § 103(a) and reviewed a proposed Supplemental Declaration of Prior Invention. Applicant has made the requested changes to the Declaration and formally submit it herewith.

I. Rejections under § 102(a)

In response to the Office Action dated 7/15/2004, Applicant submitted a Declaration showing the present invention was reduced to practice before October 23, 1996, the alleged publication date of the Webcrawler reference. The Examiner rejected this original Declaration as inadequate because it was not signed by all of the inventors and because he deemed the original Declaration too conclusory.

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In response to the Examiner's objections, Applicant submits herewith a supplemental Declaration of Prior Invention under 37 C.F.R. 1.131. Applicant believes this supplemental Declaration satisfies the requirements in MPEP 715.

In view of this Supplemental Declaration of Prior Invention, Applicant believes to have now established that the present invention was conceived before October 23, 1996, the alleged publication date of the Webcrawler reference, and either: (i) reduced to practice before October 23, 1996; or (ii) diligently reduced to practice between a date prior to October 23, 1996 and February 25, 1997, the filing date of the parent application. For at least this reason, Applicants respectfully submit that Webcrawler does not anticipate claims 1, 5, 6, 8, 14, 18, 19, 20, 24, 25, 26, 27, 28, and 29.

II. Rejections under § 103(a)

The Examiner rejected claims 2, 3, 4, 7, 10, 11, 12, 13, 15, 16, 17, 21, 22, and 23 under 35 U.S.C. § 103(a) as unpatentable over Webcrawler in view of Dazey. Applicants respectfully traverse.

A. Webcrawler is not prior art

As previously discussed, Applicants reduced the present invention to practice before October 23, 1996, the alleged publication date of the Webcrawler reference. For at least this reason, Applicants respectfully submit that the proposed combination does not obviate claims 2, 3, 4, 7, 10, 11, 12, 13, 15, 16, 17, 21, 22, and 23.

B. Even if Webcrawler were prior art, there would be no motivation to make the proposed combination.

In its response to the Office Action dated 7/15/2004, Applicant asserted that the references teach away from the proposed combination and that the references failed to suggest the desirability of the proposed combination. Applicant respectively incorporates its earlier remarks by reference and repeats the assertions therein.

In response to the Applicant's remarks, the Examiner stated in the Office Action dated 3/7/2005 that "the applicant begins the argument with an assertion that claim 1 requires at least two windows. The Examiner would like to point out that this limitation is not specifically stated in claim 1." During the interview, the Examiner clarified this position by stating that he was reading the "web page window includ[ing] a web page obtained from a server" limitation onto the 1st Webcrawler web page and the "help window . . . includ[ing] user-readable instructions that describe how to accomplish functions in the web page" limitation onto the 2nd Webcrawler

web page. That is, the Examiner read the same browser window as be the “web page window” at one point in time and the “help window” at a different point in time.

To move prosecution forward, Applicant has added the limitations of claim 2 into independent claim 1. Amended Claim 1 (originally Claim 2) now explicitly requires that “the help window [be] displayed simultaneously on the monitor with at least a portion of the web page.” New claim 30 further requires that “the help window and the web page window comprise different windows.” Applicant has also added similar language to independent Claims 8, 14, 19, 24, and 27, and notes that independent Claim 25 previously required “simultaneously displaying a help window on the browser site monitor with the browser window.”

The Examiner also stated in the 3/7/2005 Office Action that column 1, line 44 of Dazey provided motivation to make his proposed combination. That section states:

Another problem experienced by users is that the separate help window causes loss of focus and attention to the primary window. A window is said to have "focus" when it is active and currently designated to receive the user input from the keyboard or mouse. To navigate in a help window, the help option is activated and focus is transferred from the application window to the help window. ***This shift of focus makes it confusing for the user to implement the help instructions. As the user attempts to follow the simple directions for a help topic, the efforts are not effective because the keystrokes referenced in the help window are only valid when the application window has the focus.***

Dazey, col. 1, lines 44-55 (emphasis added). Applicant notes that the section cited by the Examiner actually describes the present invention and its separate help window as being “confusing” and “not effective,” rather than as being ‘desirable’ or ‘beneficial.’ Accordingly, Applicant respectfully asserts that the cited section fails to satisfy the Examiner’s burden of

establishing a prima facie case of obviousness. In fact, Applicant believes that the cited language, with its characterization of a separate help window as being “confusing” and “not effective,” actually teaches away from the present invention and its help windows. The Federal Circuit has repeatedly noted that such teaching away is compelling evidence of non-obviousness. E.g., *In re Fine*, USPQ2d 1596 (Fed. Cir. 1988).

III. Miscellaneous

Applicant respectfully submit that the amendments made in this Response will not require a new search because the amendments primarily rewrite existing claims in independent form (e.g., adding the limitations in dependent claim 2 to independent claim 1) or correct dependency in view of several canceled claims.

Applicants do not believe that any fees are associated with this preliminary amendment. However, the Patent Office is authorized to charge any fees, or credit any overpayments, to deposit account 09-0465.

IV. Conclusion


It is believed that the present application is in condition for allowance and a prompt and favorable allowance of all claims is respectfully requested. If the Examiner, upon considering

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this amendment, thinks that a telephone interview would be helpful in expediting allowance of the present application, he/she is respectfully urged to call the Applicant's attorney at the number listed below.

Date: June 7, 2005

Respectfully submitted,

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